IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants	:	George R. Borden, IV et al.	Group Art Unit:	2483
App. No.	:	09/505,449	Examiner	: Czekaj, David J.
Filed	:	February 16, 2000	Conf. No.	: 5400
Customer No.:		55648		
Title	:	METHOD OF SELECTING TARGETS AND GENERATING FEEDBACK IN OBJECT TRACKING STYSTEMS		

APPELLANTS' REQUEST FOR REHEARING

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October 20, 2011

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

BACKGROUND

In Response to the Decision on Appeal mailed August 26, 2011, the Applicants respectfully request rehearing and reversal of the Examiner's rejection of claims 1-20 of the present application.

ARGUMENT

The Decision on Appeal mailed August 26, 2011 affirmed the Examiner's rejection of claims 1-20 of the present application based on a clearly erroneous reading of the claims, failing to even address the claim limitation that the Applicants contended as distinguishing the claims over the cited prior art. Specifically, each claim includes the limitation of "receiving a user selection of an object of interest . . . while said object tracking system is activated *and while said image is being automatically increased in magnification*." (Emphasis added.) The italicized portion of this limitation formed the basis for the Applicants' contentions that the claims were distinguished over the cited prior art combination of Ito and Loveland.

For example, the Applicants' Appeal Brief clearly stated that the sole independent claim 1 "requires that an object tracking system be initiated and that automatically, in response to that initiation, the image is to be magnified until a user designates the target to be tracked. Both of the prior art references cited by the Examiner teach the reverse of this process, i.e. a target is to be designated, and *then* magnification upon that designated target is to occur." *See* Appeal Brief at pp. 4-5. (Emphasis in original,) The Applicants' Appeal Brief then went on to summarize the disclosures of Ito and Loveland in that Ito teaches an automatic surveillance system that *automatically* detects and designates an object to be tracked, *after which* magnification occurs, while Loveland merely teaches that a person can *manually* designate a target *after which* magnification automatically occurs. *See* Appeal Brief at p. 5 (Ito's magnification "preconditioned on an *earlier* identification of an object" and therefore does not disclose magnifying "as a precursor to . . . identification of an object, as is claimed by the applicant."): *Id.* at pp. 5-6 (noting that Loveland also teaches "nothing more" than magnifying an object *already* being tracked.") The Applicants' argument was therefore that any combination of Ito and Loveland would merely teach the "automated magnification of the image . . . after the step of identifying the target to be tracked, and not *vice versa* as claimed." Appeal Brief at p. 6.

The Examiner's Answer failed to address the Applicants' argument. Instead, the Examiner misrepresents the argument as a fictitious assertion that "Ito fails to disclose automatically increasing magnification of a sequence of frames of an image in response to initiating the tracking system free from further user input while the tracking system is activated." *See* Examiner's Answer at page 5 (under heading "Response to Argument"). The Applicants never made such an argument, as the Examiner simply recites limitation (b) of independent claim 1 while the Applicants' arguments were exclusively addressed to *limitation (c)* of independent claim 1. This miscast rebuttal was the *only* response by the Examiner, and was completely pointless given the Applicants' characterization of Ito as disclosing "that the object tracking system . . . is initiated when that system detects the object to be tracked, and once that system is initiated the zoom lens of the camera . . . magnifies the object already detected." See Appeal Brief at p. 5. Stated simply, the Examiner *manufactured* an issue that the Applicants did not dispute as a way of avoiding the issue that the Applicants *did* raise.

Naturally, in the Reply Brief, the Applicants made the following argument:

> The Examiner responds by mischaracterizing the applicant's argument as merely averring that "Ito fails to disclose automatically increasing magnification of a sequence of frames of an image in response to initiating the tracking system free from further user input while the tracking system is activated." This was not the applicant's argument. The applicant assumed the correctness of the Examiner's reading of limitation (b) of claim 1 on Ito's disclosure of automatically zooming in on an identified object, but then argues that given this reading, the combination of Ito and Loveland would not disclose limitation (c), which requires that the identification of the object to be tracked occur *during* the zooming operation. The Examiner has made no response to this argument. Instead, the Examiner merely reiterates the applicant's point that "Ito discloses in column 12, lines 21-29, that *upon detecting an entering object*, a zoom control signal is generated which automatically magnifies the image on the screen."
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> Finally, the applicant notes that The Examiner cites no disclosure in either Ito or Loveland where an object of interest is selected *during* a zooming operation begun by initiating an object tracking system.

Reply Brief at pp. 5. (Emphasis added and citations omitted.) Given that the prior art magnification occurs *after* an object has *already* been designated, limitation (c) *cannot* be obvious; if magnification occurs in *response to* the designation of an object to be tracked, and in fact where magnification is merely a part of the prior art function of actually tracking the object previously-designated, then the presently claimed step of designating an object to be tracked *during* magnification would be completely superfluous in the prior art methods – why select an object to be tracked *during* magnification if the prior art requires that the object *already* be selected in order to zoom in on it?

The decision of the Board of Appeals, somehow, also completely misses the relevant limitation, even though the Applicants' arguments were exclusively devoted to it. For example, the Decision on Appeal begins with the false assertion that the Applicants contended "that neither Ito nor Loveland teaches initiating an object tracking system and automatically magnifying an image free from further user input." *See* Decision on Appeal at p. 4. As noted above, the Applicants made no such contention. Quite the opposite, the Applicants characterized Ito as teaching that an image is automatically magnified in response to initiating an object tracking system. The Applicants merely noted that what initiated Ito's tracking system was the designation of an object. *See e.g.* Examiner's Answer at p.3 (stating that Ito's system is initiated once an object to be tracked is automatically selected) [1]

The Board of Appeals also bizarrely states that "[f]or the first time in the Reply Brief, the Applicants' further contend that Loveland does not teach selecting an object of interest while the tracking system is activated." *See* Decision on Appeal at p. 4. This is

[1] Neither did the Applicants contend that Ito requires a *user* identification of a target as implied by the Board of Appeals. See Decision on Appeal at p. 4. The Applicants actually stated that Ito's target designation was *automatic*. Moreover, if the Board of Appeals is trying to argue automatic zooming can occur "on an object" without that object being "selected or designated", such an assertion makes no sense; if no object has been designated as a target there would be nothing to *automatically* zoom in on. Finally, the contention that "contrary to Appellants' assertions . . . claim 1 does not require magnification occur without identifying an object" is puzzling. There was no such assertion. The Applicants merely noted that claim 1 requires that designation of an object occur *during* magnification – an assertion subtly different from the Board's restatement, and one that cannot be reasonably disputed given the plain language of the claim. The Applicants then reasoned that, since *both* prior art references teach magnification *as part of the tracking process* that occurs *after* the object to be tracked has been identified, the claimed step is not obvious. To date, neither the Examiner nor the Board of Appeals has addressed this simple argument.

again a complete mischaracterization of the Applicants' argument, which was that Loveland (as well as Ito) failed to disclose the step of selecting an object of interest "*during a zooming operation begun by* initiating an object tracking system." *See* Reply Brief at p. 6. This argument (when correctly stated) was not new. *See* Appeal Brief at pp. 4-5 (Claim 1 "requires that . . . the image is to be magnified until a user designates the target that is to be tracked. Both of the prior art references . . . teach the reverse of this process, i.e. a target is to be designated and *then* magnification upon that designated target is to occur."); *Id.* at 5 ("Loveland also teaches nothing more than zooming in and out on an object *already identified* as one to be tracked." (emphasis added); *Id.* at 6 (even if Ito and Loveland were combined "the step of automated magnification of the image would still occur after the step of identifying the object to be tracked.")

Ironically, in citing to *Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010) the Board of Appeals highlights the obligation to *reverse* the Examiner's rejection. In that decision, the Board of Appeals emphasized the necessity of fairness to the parties in being able to respond to arguments used to affirm or reverse a rejection.[2] In the present case, all claims are rejected under 35 U.S.C. § 103(a) which requires that an Examiner provide a reasoned explanation of obviousness, which in turn requires a demonstration that all claim limitations are either taught in the prior art, or if a limitation is not found in the prior art, an explanation as to why it is obvious in view of the prior art.

All claims include the limitation of "receiving a user selection of an object of interest . . . *while said image is being automatically increased in magnification.*" *See* claim 1, limitation (c). This limitation is not found in the prior art. A careful review of the Examiner's rejection shows that no contention is made that Ito – the primary reference – discloses the limitation. *See* Examiner's Answer at p. 3 (merely citing Ito to show a prior art disclosure of limitations (a) and (b) of claim 1). Neither does the Examiner cite any disclosure in *Loveland* of this limitation. *See Id* at 3 (pretending as if the only limitation in claim 1 absent from Ito, which needs be disclosed by Loveland to support the

[2] *Ex parte Borden* focused on fairness to the Examiner, which is technically not relevant given that the Examiner is not a party to the proceeding (hence the "ex parte" designation) and has no due process rights to be protected. The Applicants, however, are a party and *do* have due process rights that must be protected.

obviousness rejection is limitation (d) – and thus skipping limitation (c) entirely); *See also Id.* at p. 4 (citing lines of Loveland disclosing only that part of limitation (c) relating to selecting an object of interest while a tracking system is activated); *see also* Loveland at col. 3 lines 56-59 ("The tracking system is activated by the guard who uses the mouse to click on a person . . . . The tracking system *then* takes over control of the panning and zooming functions.") (Emphasis added).

Because neither reference discloses the relevant claim limitation of "receiving a user selection of an object of interest . . . *while* said image is being automatically increased in magnification", the only way the Examiner could have supported a prima facie case of obviousness was a reasoned explanation as to why, in view of the teachings of the two cited reference, the *limitation* was obvious even though it was not expressly taught. Instead, the Examiner merely provided an assertion that one of ordinary skill in the art would "add the tracking taught by Loveland [to the apparatus of Ito] in order to . . . allow[ ] a user to perform more tasks since the user's full attention is no longer required." *See* Final Rejection mailed December 24, 2008 at p 3; *See also* Examiner's Answer at p. 4. This explanation has nothing to do with a user selecting an object of interest "while" an image is being magnified, it merely explains the benefit of selecting an object of interest so that it can *subsequently* be tracked automatically.

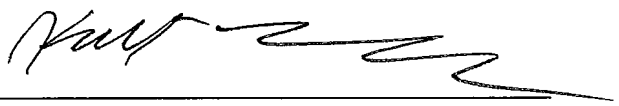
Neither an Examiner, nor an appeal board, may belatedly supply a required element of a prima facie case of obviousness during an appeal proceeding to affirm a rejection, as the applicant would not be given a fair chance to respond to the rejection. *Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010). Affirming a rejection under these circumstances would, at a minimum deprive an applicant of the patent term extension that remediates the delay occasioned by appealing an improper rejection. In this instance, the rejection being appealed ignored an entire limitation in the only independent claim of the application - selecting an object of interest "while said image is being automatically increased in magnification." After the Applicants correctly noted that neither reference disclosed this limitation, and in fact taught only the reverse, i.e. selecting an object of interest *prior to* magnification upon the object to continually track it, the single response of both the Examiner and the Board of Appeals was to pretend that the argument (and the limitation) did not exist, and instead misrepresent the

argument being raised as if the asserted missing limitation was merely "selecting an object of interest *while the object tracking system is activated.*"[3] The limitation upon which the Examiner and the Board of Appeals focuses is completely irrelevant. At no point did the Applicants argue that this limitation distinguishes the claims over the cited prior art.

CONCLUSION

Because the Decision on Appeal misrepresented the arguments presented to it by the Applicants, and failed to even discuss the claim limitation that the Applicants actually argued as distinguishing the claims over the prior art, the Board of Appeals should grant rehearing. Because the Examiner's final rejection, as well as the Examiner's Answer, failed to show any prior art disclosure of the limitation of "receiving a user selection of an object of interest . . . *while said image is being automatically increased in magnification*" and similarly failed to provide a reasoned explanation of why *that* limitation would be obvious despite its absence from the prior art, the Examiner failed to state a prima facie case of obviousness and the respective rejections of claims 1-20 should be reversed, and the claims should be found patentable.

Respectfully submitted,



Dated: October 20, 2011

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[3] Given the Applicants' persistent focus on the claim limitation "while said image is being automatically increased in magnification" in both the appeal brief and the reply brief, it is hard to understand how the Decision on Appeal could both frame the issues and analyze the appeal *without even discussing the limitation*. See Decision on Appeal at pp. 3-7. After cursorily quoting claim 1 in its entirety, the Board of Appeals quite literally ignored the limitation most relevant to this appeal.